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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,152	07/08/2003	Parris S. Wellman	14641Z (ETH-1559CONT)	8263

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,152

Applicant(s)

WELLMAN ET AL

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3739

Applicant's preliminary amendment of July 8, 2003 is acknowledged. In particular, claims 1-20 have been canceled in favor of new claims 21-31. The following is a complete response to the July 8, 2003 preliminary amendment.

***Specification***

The disclosure is objected to because of the following informalities: the reference to prior applications should be updated to provide the most current (i.e. US Patent Number) of the related application.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly filed claims recite a "hook member" which is not disclosed in the original specification. For the purposes of examination, it is assumed the "hook member" is the curved portion at the distal end of slot (106). Additionally, the original specification fails to support the recitation of an electrode on the hook member as set forth in claims 22-26 and 28. The original specification recites

Art Unit: 3739

that the electrode may be located on the edge (106a) of the slot as recited at page 10, lines 20-22.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Abele et al (5,190,541).

Abele et al disclose a surgical device comprising a shaft (12) having an internal lumen and a hook member (16) in communication with a slot at the end of the shaft. A clamp member (54) is slidably disposed in the slot to clamp tissue against the hook member, and a cutting member (56) is slidingly disposed in the lumen and extendable into the slot to cut tissue held by the clamp member (see Figures 5a-5c). Various electrode configurations are provided where each of the hook, the clamp member and the cutting member may include an electrode (see Figure 5a).

Claims 21-23, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Noda (5,366,476).

As best depicted in Figures 7A and 7B, Noda discloses a device comprising a shaft (106) having an internal lumen and a hook member (42) in communication with a

Art Unit: 3739

slot. A clamp member (46) is slidable in the slot to clamp tissue against the hook member. Each of the hook member and the clamp includes an RF electrode.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al (6,224,593) in view of the teaching of Abele et al (5,190,541).

Ryan et al discloses a surgical device that includes a shaft (10) having an internal lumen, and a hook (36) at the distal end of the shaft in communication with a slot. Ryan et al also disclose a clamp member (42) slidable in the slot to clamp tissue against the hook member. Ryan et al disclose a microwave electrode arrangement for treating tissue, and not RF electrodes, and fail to disclose an electrode on the hook member. Ryan et al also fail to disclose a cutting member.

As disclosed previously, Abele et al disclose an analogous clamping/heating instrument and specifically disclose the use of RF electrodes and a cutting member to cut tissue after its been clamped.

To have provided the Ryan et al device with RF electrodes, in lieu of the microwave electrodes, would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Abele et al. To have further provided the Ryan et al

Art Unit: 3739

device with a cutting member to cut tissue after its been clamped and treated would have been an obvious modification in view of the Abele et al teaching.

Claims 24-26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda (5,366,476) in view of the teaching of Abele et al (5,190,541).

The Noda device has been previously addressed. Noda fails to disclose a separate clamping member and cutting member. Rather, the paddle (46) on Noda serves as both a clamping member and a cutting member.

Abele et al, as previously discussed, disclose a clamp device and a separately slidable cutting member.

To have provided the Noda device with separate clamping and cutting devices would have been an obvious design consideration for one of ordinary skill in the art, particularly in view of Abele et al who discloses an analogous device with separate cutting and clamping members.

### ***Conclusion***

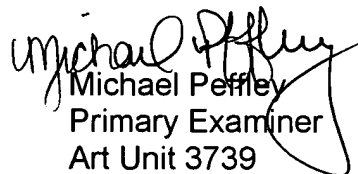
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McClurken et al (6,558,385) discloses a clamping device that includes a shaft member, a distal hook portion and a clamp member movable in a slot. Philips (5,304,176) discloses another electrosurgical device including a distal hook member connected to a shaft.

Art Unit: 3739

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
March 29, 2005